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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,232

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Anthony Wlodarczyk

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20583

7590

11/23/2009

JONES DAY  
222 EAST 41ST ST  
NEW YORK, NY 10017

EXAMINER

VARNUM, RYAN A

ART UNIT

PAPER NUMBER

3751

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11/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,232	<b>Applicant(s)</b> WLODARCZYK, ANTHONY	
	<b>Examiner</b> RYAN A. VARNUM	<b>Art Unit</b> 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                           | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/22/2006; 11/30/2006</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This office action is responsive to the amendment filed on 8/22/2006. As directed by the amendment: claims 1-10 have been cancelled and claims 11-22 have been added. Thus, claims 11-22 are presently pending in this application.

### ***Specification***

2. The abstract of the disclosure is objected to due to its excessive length over 150 words. Correction is required. See MPEP § 608.01(b).

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Objections***

4. Claim 13 is objected to due to the following informalities: it appears that the term “begin” (Line 2) should be replaced with the term “being”. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

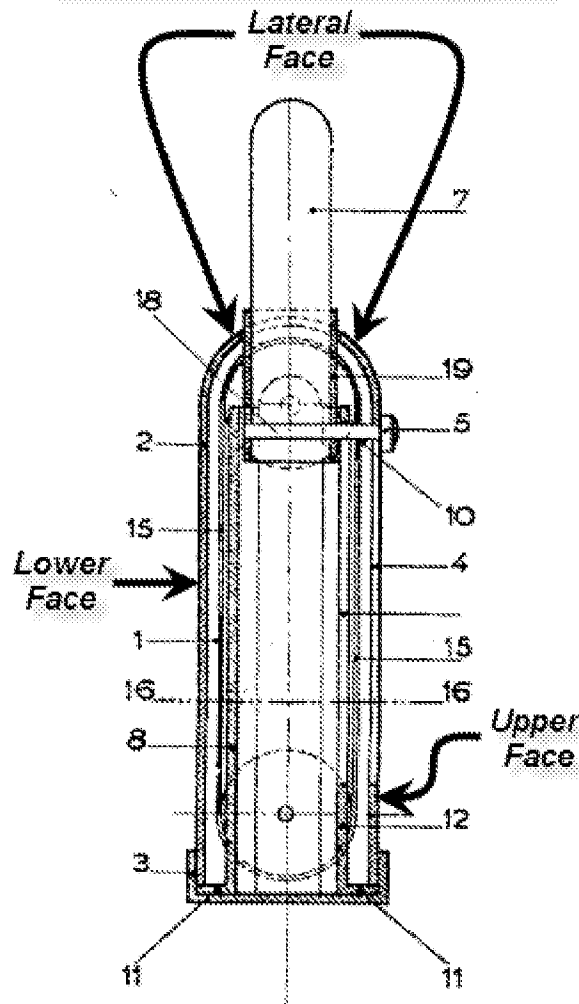
6. Claims 11-15, 17-19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Pecq (FR Patent 944022). The Examiner notes that all references to the Pecq specification are made with regard to the machine translation, a copy of which is provided with this action.

7. In re Claims 11, 12 and 22, Pecq discloses a device capable of being used as a writing implement comprising: a body 2 (Fig. 1) having an opening (See Fig.'s 1 and 2, the opening sealed by surface 1 in Fig. 1 and penetrated by writing tip 7 in Fig. 2) through which a writing tip 7 (“make up stick”; Fig. 2; Para 2, Line 4) passes along a longitudinal direction (See Fig. 2), and a slot 4 (Fig.'s 1-2) extending approximately along the longitudinal direction (Fig.'s 1-2); a support 19 (“tube carry make up”; Fig. 2; Para 2, Line 3) on which the writing tip is mounted (See Fig. 2), said support being

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placed inside said body (See Fig. 2); a strip 1 ("foil"; Fig.'s 1, 2 and 5; Para 7, Line 1) comprising a first portion fixed to said support (See Fig. 2; it being seen that the strip 1 is fixed to support 19 by way of stud 18; Para 2, Lines 1-4), a central portion and an end portion guided along a curved path (See Fig.'s 2, 3 and 5; it being seen that the strip 1 has an end and a central portion; and the curved path being defined by the space between rollers 6 and the body 2), said strip being flexible (Para 7, Line 1 to Para 10, Line 2) and capable of being moved between two positions (See Fig.'s 1-2), namely a writing position in which said strip gives access to the opening (See Fig. 2) and a stowing position in which said strip closes off the opening (See Fig. 1); and a button 5 (Fig.'s 1-2) connected to said support (See Fig. 2), said button being capable of being moved along the slot between a distal position relative to the opening, for which said support and said strip are in the stowing position (See Fig. 1), and a proximal position relative to the opening, for which said support and said strip are in the writing position (See Fig. 2); wherein said body includes a lower face and an upper face connected together by at least one lateral face having a small height so as to produce a writing implement having a substantially flat shape (See Annotated Fig. 2 below), and wherein the slot 4 (Fig.'s 1-2) is made in the upper face (See Annotated Fig. 2 below), and the opening is made in the lateral face (See Annotated Fig. 2 below) along which the end portion of said strip moves between the writing position and the stowing position (See Fig.'s 1-2); the end portion of said strip possesses an oblong window 15 (See Fig. 5) which, in the writing position, is positioned so as to face the opening for the passage of the writing tip (See Fig. 2).

## **Annotated Fig. 2**



8. In re Claims 13-15 and 17-19, Pecq further discloses said button 5 (Fig.'s 1-2) is connected to said support 19 (Fig. 2) by a lug 18 ("stem"; Fig. 2) passing through the slot 4 (Fig. 2), the lug being fixed by a tongue 18 ("stem"; Fig. 2) perpendicular to the first portion of said strip (See Fig. 2; it being seen that the stem 18 serves the function of both a lug for holding the button and a tongue for fixing the button to the strip); wherein

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the lug, the tongue and said strip comprise a unitary member (See Fig. 2, it being seen that the three structures are assembled in engagement with one another); the upper and lower faces are substantially oval (See Fig. 1 and Annotated Fig. 2 above; it being seen that the faces of the device are substantially oval in the sense that they each have an oval end); said support butts against the internal wall 8 (Fig. 2) of said body during its displacement in the writing position (Para 3, Lines 2-3; "tube carry-make-up 19 in slides 8 in form"; it being understood that support 19 abuts the internal wall 8 as it slides along it to the writing position).

9. In re Claim 19, Mitchell further discloses the first portion of said strip 1 (Fig. 5) is curved generally in the form of a 'U' (See Fig. 1; it being understood that when the button 5 is at the lowermost position the first portion of the strip, being that portion adjacent the button 5, is in the form of a 'U' due to it's being wrapped around the lower roller 6, as depicted in Fig.'s 2-3), the translation of said button 5 (Fig.'s 1-2) causing a displacement of the first portion of said strip in the same direction, and a displacement of the end portion of said strip in the opposite direction.

10. Regarding the end portion of the strip 1, for the purpose of Claim 19, the end portion will be identified as that portion of the strip 1 which covers the opening at the end of the body 2 when in the stowed position, as depicted in Fig. 1. Thus, it is understood that when the button 5 and the adjacent first portion are moved in a direction towards the proximal end of the body from the opening that the end portion will move in an opposite direction towards the distal end of the body from the opening (See Fig.'s 1-2).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pecq. Pecq discloses the button 5 having a surface that extends from the lug over a length of the slot (See Fig.'s 1-2; it being understood that the surface of button 5 does cover a portion of the slot, although a small portion); although Pecq does not disclose the surface being of sufficient length suitable for entirely covering the slot while in the stowed position. However, it is the Examiner's opinion that it would have been an obvious matter of design choice to adjust the length of the surface of the button such that it was capable of covering the entirety of the slot while the device was in the stowing position, for the purpose of providing a more aesthetically appealing design which also provides the additional benefit of prevent debris from entering into the inner parts of the device while it is carried on a user's person in a stored manner, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).



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13. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecq in view of Brand et al. (US Patent 6,964,534).

14. In re Claim 20, although Pecq does not disclose the first portion being joined to the central portion at an angle, attention is directed to Brand which teaches a writing instrument comprising a body, a writing tip, a support and a strip 320 ("sliding door"; Fig.'s 19-23; Column 10, Line 47) having an oblong window 326 ("elongate slot"; Fig.'s 19-23; Column 10, Line 58) , wherein the first portion 366 ("prong"; Fig. 21; Column 10, Line 39) of said strip 320 is joined to the central portion 322 ("upper portion"; Column 10, Line 50) at an angle (See Fig.'s 19-23), the translation of the first portion and the displacement of the central portion and of the end portion (the end portion being the portion in which oblong window is located) being in the same direction (See Fig.'s 19-23), for the purpose of providing a writing device which is capable of self-sealing in so as to prevent the writing nib from drying out (Abstract).

15. Accordingly, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to modify the device of Pecq by replacing the self-sealing strip and button structure with one wherein the translation of the first portion and the displacement of the central portion and of the end portion are in the same direction, as taught by Brand, for the purpose of providing a writing device which is capable of self-sealing in so as to prevent the writing nib from drying out.

16. In re Claim 21, Brand further discloses that it is well known in the art to provide a writing tip which includes a felt tip (Column 1, Lines 17-20).

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dopp (US Patent 4,706,995) which discloses a substantially flat and oval pen having a sliding button engaged in a slot disposed on an outer surface of the pen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. VARNUM whose telephone number is (571) 270-7853. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. V./  
Examiner, Art Unit 3751

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/David J. Walczak/

Primary Examiner, Art Unit 3751